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SEP 20 2006

In re Application of	:	<b>OFFICE OF PETITIONS</b>
Noel et al.	:	
Application No. 09/733,773	:	DECISION ON APPLICATION
Filed: December 8, 2000	:	FOR
Attorney Docket No. SALK2410	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705," filed December 28, 2005. Applicants request correction of the patent term adjustment from three hundred fifty-six (356) days to seven hundred three (703) days solely on the basis of the Office taking in excess of three years to issue the patent (given the projected patent issue date).

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date<sup>1</sup>. To this extent, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentees may seek such consideration without payment

<sup>1</sup> Applicants otherwise agree with the adjustments and reductions of record at the time of the mailing of the notice of allowance.

of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

However, it is noted that a review of the application history reveals a further basis for entry of a period of reduction. Specifically, 37 CFR 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

Further, as stated in the final rule, the reference to "1.135(c)" is parenthetical because 1.704(c)(7) is not limited to Office actions under 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 1.821 et seq.

In this instance, a response to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) filed June 4, 2001 was determined to contain an omission and a response correcting the omission was filed on July 9, 2001. Accordingly, a period of reduction of 35 days should have been entered.

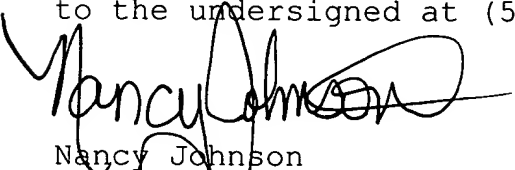
In view the correct patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred twenty-one (321) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred twenty-one **(321)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required. The fee is required and will not be waived.

The Office of Patent Publication has been advised of this decision. The application is, thereby, being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Saturday  
Date: 9/16/2006

# PALM INTRANET

Time: 17:08:03

## PTA Calculations for Application: 09/733773

Application Filing Date:	12/08/2000	PTO Delay (PTO):	508
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	152
Post-Issue Petitions:	0	Total PTA (days):	321
PTO Delay Adjustment:	-35		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
63	09/16/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		35	
48	09/29/2005	MAIL NOTICE OF ALLOWANCE			
47	09/22/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
45	09/22/2005	ISSUE REVISION COMPLETED			
44	09/22/2005	NOTICE OF ALLOWABILITY			
43	09/22/2005	DATE FORWARDED TO EXAMINER			
42	09/02/2005	AMENDMENT AFTER FINAL REJECTION		57	34
41	09/02/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
39	07/28/2005	MAIL ADVISORY ACTION (PTOL - 303)			
38	07/25/2005	ADVISORY ACTION (PTOL-303)			
37	07/13/2005	DATE FORWARDED TO EXAMINER			
36	07/07/2005	AMENDMENT AFTER FINAL REJECTION			
35	06/23/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
34	04/07/2005	MAIL FINAL REJECTION (PTOL - 326)			
33	04/04/2005	FINAL REJECTION			
32	01/28/2005	DATE FORWARDED TO EXAMINER			
31	01/18/2005	RESPONSE AFTER NON-FINAL ACTION		33	29
30	01/18/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	09/16/2004	MAIL NON-FINAL REJECTION			
28	09/15/2004	NON-FINAL REJECTION			
27	07/15/2004	DATE FORWARDED TO EXAMINER			
26	05/24/2004	RESPONSE AFTER NON-FINAL ACTION		62	20
25	05/24/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			

24	05/24/2004	WORKFLOW INCOMING PETITION IFW			
22	05/24/2004	WORKFLOW INCOMING AMENDMENT IFW			
21	02/04/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
20	12/23/2003	MAIL NON-FINAL REJECTION			
19	12/18/2003	NON-FINAL REJECTION			
18	10/01/2003	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
17	10/14/2003	DATE FORWARDED TO EXAMINER			
16	10/01/2003	RESPONSE AFTER NON-FINAL ACTION			
15	07/01/2003	MAIL NON-FINAL REJECTION	508		-1
14	06/30/2003	NON-FINAL REJECTION			
13	02/07/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	03/25/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	01/16/2002	APPLICATION DISPATCHED FROM OIPE			
10	01/15/2002	APPLICATION IS NOW COMPLETE			
9	08/22/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
8	07/10/2001	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
7	05/17/2001	CORRESPONDENCE ADDRESS CHANGE			
6	03/05/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
5	03/05/2001	CORRESPONDENCE ADDRESS CHANGE			
4	01/08/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
3	01/04/2001	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
2	12/08/2000	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	12/08/2000	INITIAL EXAM TEAM NN			

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**EXPLANATION OF PTA CALCULATION**

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